

REMARKS

Claims 1-15 and 20-34 are pending in the application.

Claims 1-14, 20-32 and 34 have been rejected.

Claims 15 and 33 are objected to.

I. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 9-13, 20 and 27-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Constantin (US Patent No. 6,198,725) in view of Daniel (US Patent No. 5,726,985) and Widegren (US Patent No. 6,374,112) and Geagan III (US Patent No. 6,263,371).

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Constantin (US Patent No. 6,198,725) in view of Daniel (US Patent No. 5,726,985) and Geagan III (US Patent No. 6,263,371) and Thorson (US Patent No. 4,440,986).

Claims 3, 6-8, 21 and 24-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Constantin (US Patent No. 6,198,725) in view of Daniel (US Patent No. 5,726,985) and Geagan III (US Patent No. 6,263,371) and Yamato (US Patent No. 5,694,390).

Claims 4-5 and 22-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Constantin (US Patent No. 6,198,725) in view of Daniel (US Patent No. 5,726,985) and Geagan III (US Patent No. 6,263,371) and Campbell (US Patent Application Publication 2003/0140159).

Claims 14 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Constantin (US Patent No. 6,198,725) in view of Daniel (US Patent No. 5,726,985) and Yamato (US Patent No. 5,694,390) and Geagan III (US Patent No. 6,263,371) and Thorson (US Patent No. 4,440,986).

The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP §

2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

In the prior response, Applicant amended independent Claims 1, 2 and 20 to recite at least a one of reconfiguring a switching matrix within the network and reducing a number of channels in the network (and certain language regarding the reduction of the size of voice packets has been deleted). Applicant further asserted the combination of references does not disclose adapting the bandwidth of a network (to maintain a QOS) by reducing the number of channels.¹ In reply, the outstanding Office Action argues the combination of references actually does disclose this function because “where a new connections are not permitted, the number of active connections will decrease.” Office Action, page 2. Applicant respectfully disagrees. Refusing to establish a connection does not equate to “reducing the number of channels in the network.” Not establishing a connection does not necessarily reduce the number of channels – it just does not increase the number of channels.² Thus, when the measured parameter differs from a predetermined parameter (predetermined value) - indicating a QOS issue such as congestion - bandwidth optimization is enabled (or an optimization mechanism adjusts the bandwidth) which includes at least a one of reconfiguring a switching matrix in the network and reducing the number of channels in the network.

The Office Action fails to identify any passages from any of the cited references that disclose or teach wherein enabling bandwidth optimization includes (1) reconfiguring a switching matrix within the network or (2) reducing the number of channels in the network. In fact, the Office Action appears to erroneously conclude that the claims include a limitation directed to “providing an optimization that reduces the size of voice packets transported in the network.” See, Office Action, page 3, paragraph 3. This is incorrect. Next, the Office Action

¹ The Office Action appears to concede the references, either alone or in combination, do not disclose or teach enabling bandwidth optimization by “reconfiguring a switching matrix within the network.”

² Moreover, the claims do not specifically recite or require the establishment of a new connection, or recite steps performed that relate to, or are in response to, setting up a new connection. The bandwidth optimization may be performed when the measured parameter (associated with a data packet transported across the network) differs from a predetermined value.

fails to identify any portion of Widegren at issue, and fails to identify any portion of any of the cited references that disclose or teach either (1) reconfiguring a switching matrix within the network or (2) reducing the number of channels in the network. Therefore, the Office Action has failed to establish a prima facie case of obviousness with respect to independent Claims 1, 2 and 20 (and their dependent Claims).³ In the next Office Action, Applicant requests a proper identification of those specific portions (if any) within the cited reference(s) which disclose, teach or suggest the above-identified claim language.

Neither Daniel, Widegren or Thorson appear to disclose the above-referenced recited features/elements. Accordingly, the proposed combinations for rejecting independent Claims 1, 2 and 20 do not disclose, teach or suggest every element/feature recited in the claims. Therefore, the Applicant respectfully requests withdrawal of all of the § 103 rejections of independent Claims 1, 2 and 20 (and their dependent Claims 3-15 and 21-33).

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

³ In addition, Constantin does not appear to describe or disclose reconfiguring a switch matrix in the network or reducing the number of channels in the network. Though Constantin makes no connection when the delay budget cannot be met, Applicant respectfully submits that this is not equivalent to “reducing” the number of channels in the network. Constantin merely does not allow a connection to proceed, and no reduction in the number of channels is implemented. Failing to establish a new connection is not equivalent to “reducing” the number of channels.


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

MUNCK CARTER, LLP

Date: 7/14/2009


Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@munckcarter.com*